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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,639	04/07/2000	Ryan Cunningham	72189/99664	9723

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 06/17/2004

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,639

Applicant(s)

CUNNINGHAM ET AL.

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 33-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-22 and 33-60 is/are rejected.
- 7) ☒ Claim(s) 8 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This Action is in regards to the latest responds received on 02 March 2002.
2. The Examiner acknowledges the election of Group I, claims 1-23 and 33-60.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-6, 11-22, 33-38, 41-52 and 55-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over Radziewicz et al. (Radziewicz), U.S. Patent No. 5,854,897 in view of Reilly et al. (Reilly), U.S. Patent No. 5,740,549.

5. Regarding **claim 1**, Radziewicz discloses the invention substantially as claimed.

Radziewicz discloses a method of providing a user computer with access to files of a network [see Radziewicz, Col. 5, lines 8-67 and Col. 6, lines 1-13], the method comprising: establishing a communication link from the user computer to an access control system of the network [see Radziewicz, Col. 6, lines 39-41]; launching a viewer program that controls the status of the communication link [see Radziewicz, Col. 6, lines 33-64]; detecting times when the user is not actively sending or receiving data from the network [see Radziewicz, Col. 6, lines 13-16], and downloading ad files from the network to the user computer during such times, such that the viewer program maintains a pool of ad files at the user computer for display [see Radziewicz, Col. 10, line 39]; periodically opening a viewer program window in which a next ad file from the ad file pool is displayed (Radziewicz teaches that advertisements are played/displayed until

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either another advertisement is ready to be played/displayed or until the user at the DTE aborts or terminates the session), [see Radziewicz, Col. 9, lines 23-41 and Col. 10, lines 54-65]; hiding the viewer program window after a predetermined number of ad files from the ad file pool have been played and keeping the viewer program window hidden for a predetermined quiet interval (Radziewicz teaches that a display timer is set which allows a predetermined minimum display time to be specified for each advertisement), [see Radziewicz, Col. 9, lines 23-29]. However, Radziewicz does not explicitly disclose performing pool management tasks and managing the ad pool so as to keep track of the number of times each ad file in the ad pool has been viewed and determine when each ad file in the ad pool should no longer be viewed.

6. In the same field of endeavor Reilly discloses (e.g., a information and advertising distribution system and method). Reilly discloses performing pool management tasks and managing the ad pool so as to keep track of the number of times each ad file in the ad pool has been viewed and determine when each ad file in the ad pool should no longer be viewed (Reilly teaches the subscriber workstation contains an administration manager (180) that schedules and controls all communications with the information server and that also includes a connection scheduler that initiates execution of the connection manager so that it integrates the information software procedures received from the information server in addition to the storing of advertisements, images and display scripts), [see Reilly, Col. 6, lines 17-61].

7. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Reilly's teachings of information and advertising distribution system and method with the teachings of Radziewicz, for the purpose of disseminating information and advertisements to subscriber computers in a system where the

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information and advertisements are automatically displayed when the subscriber's computer is on but meets predefined idleness criteria [see Reilly, Col. 2, lines 25-29]. By this rationale **claim 1** is rejected.

8. Regarding **claim 2**, Radziewicz-Reilly further discloses wherein managing the ad pool includes determining that an ad file should not be viewed after the ad file has been viewed a predetermined number of times [Radziewicz, Col. 15, lines 35-67 and Col. 16, lines 1-26]. By this rationale **claim 2** is rejected.

9. Regarding **claim 3**, Radziewicz-Reilly further discloses wherein managing the ad pool includes determining that an ad file should not be viewed after the ad file has been viewed for a predetermined number of calendar days [see Radziewicz, Col. 14, lines 61-67 and Col. 15, lines 1-53, and TABLE 2]. By this rationale **claim 3** is rejected.

10. Regarding **claim 4**, Radziewicz-Reilly discloses wherein managing the ad pool includes discarding an oldest ad file from the ad pool if the ad pool size exceeds a predetermined size limit value [see Reilly, Col. 10, lines 38-41]. The motivation that was used in the combination of claim 1, applies equally as well to claim 4. By this rationale **claim 4** is rejected.

11. Regarding **claim 5**, Radziewicz-Reilly discloses wherein managing the ad pool includes not tracking an ad file as having been viewed if the viewing of the ad file is prematurely halted before normal completion ((The Examiner takes Official Notice, see MPEP 2144.03). By this rationale **claim 5** is rejected.

12. Regarding **claim 6**, Radziewicz-Reilly further discloses further wherein the viewer program maintains an ad information table of a local database in the user computer [see Reilly,

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Col. 15, lines 19-40]. The motivation that was used in the combination of claim 1, applies equally as well to claim 6. By this rationale **claim 6** is rejected.

13. Regarding **claim 11**, Radziewicz-Reilly further discloses wherein the access control system includes an Ad server that provides the ad files to a user, a Network Access Server that assigns a network address for an authorized user, and an Access, Authorization, [see Radziewicz, Col. 6, lines 33-64] and Accounting server that determines if authorization should be granted to a user [see Radziewicz, Col. 9, lines 64-67, Col. 10, lines 1-53 and Col. 12, lines 45-61]. By this rationale **claim 11** is rejected.

14. Regarding **claim 12**, Radziewicz-Reilly further discloses including: determining ad impression viewing data corresponding to the number of times each ad file in the ad pool has been viewed [see Reilly, col. 5, lines 60-65]; determining click through data corresponding to network addresses visited by the user during the viewing of an ad file; and reporting the ad impression viewing data to the access control system [see Reilly, Col. 5, lines 60-67 and Col. 6, lines 1-15]. The motivation that was used in the combination of claim 1, applies equally as well to claim 12. By this rationale **claim 12** is rejected.

15. Regarding **claim 13**, Radziewicz-Reilly further discloses further including storing state information for the viewing program at the user computer (The Examiner takes Official Notice, see MPEP 2144.03). By this rationale **claim 13** is rejected.

16. Regarding **claim 14**, Radziewicz-Reilly discloses wherein the viewer program displays closed captioning information (The Examiner takes Official Notice, see MPEP 2144.03) that it was well known in the networking art at the time the invention was made to utilize close captioning for the displaying of viewer programs). By this rationale **claim 14** is rejected.

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17. Regarding **claim 15**, Radziewicz-Reilly further discloses wherein the viewer program tracks the number of online network access sessions by the user computer [see Reilly, Col. 5, lines 60-67 and Col. 6, lines 1-10]. The motivation that was used in the combination of claim 1, applies equally as well to claim 15. By this rationale **claim 15** is rejected.

18. Regarding **claim 16**, Radziewicz-Reilly further discloses wherein the viewer program tracks the time spent online with network access by the user computer (The Examiner takes Official Notice, see MPEP 2144.03). By this rationale **claim 16** is rejected.

19. Regarding **claim 17**, Radziewicz-Reilly further discloses wherein establishing a communication link includes: receiving user identification information [see Radziewicz, Col. 6, lines 38-46]; verifying demographic information for the identified user stored at the access control system and providing the communication link [see Reilly, Col. 7, lines 45-54]; collecting demographic information from the user computer in an initial registration and access operation, storing the demographic information at the access control system and identifying it with the registered user, and providing the communication link [see Reilly, Col. 7, lines 49-67 and Col. 8, lines 1-19]; and otherwise terminating the communication link and denying network access. By this **claim 17** is rejected.

20. Regarding **claim 18**, Radziewicz-Reilly further discloses including: determining ad impression viewing data corresponding to the number of times each ad file in the ad pool has been viewed [see Reilly, Col. 5, lines 60-67 and Col. 6, lines 1-10]; determining click through data corresponding to network addresses visited by the user during the viewing of an ad file [see Radziewicz, Col. 9, lines 63-67 and Col. 10, lines 1-15]; and reporting the ad impression viewing

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data to the access control system [see Radziewicz, Col. 9, lines 63-67 and Col. 10, lines 1-15].

By this rationale **claim 18** is rejected.

21. Regarding **claim 19**, Radziewicz-Reilly further discloses further including preparing a Demographic Report that summarizes the reported ad impression viewing data for multiple computer users over a current time period [see Reilly, Col. 6, lines 1-10]. By this rationale **claim 19** is rejected.

22. Regarding **claim 20**, Radziewicz-Reilly further discloses further including providing the Demographic Report to a computer user identified as an ad file sponsor (The Examiner takes Official Notice, see MPEP 2144.03), (see also Gerace, U.S. Patent No. 5,848,396, whereas it discloses a sponsor object in relation to a user). By this rationale **claim 20** is rejected.

23. Regarding **claim 21**, Radziewicz-Reilly further discloses wherein the Demographic Report includes demographic report fields that are selected by the computer user [see Reilly, Figure 5]. By this rationale **claim 21** is rejected.

24. Regarding **claim 22**, Radziewicz-Reilly further discloses wherein providing the Demographic Report includes providing archival reports for prior time periods [see Reilly, Col. 6, lines 1-10]. By this rationale **claim 22** is rejected.

25. **Claims 33-38** have similar limitations as that of claims 1-6 therefore they are rejected under the same rationale as discussed above.

26. **Claims 41-46** have similar limitations as that of claims 1 and 11-16 therefore they are rejected under the same rationale as discussed above.

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27. **Claims 47-52**, list all the same elements of claim 1-6, but in program product form rather than method form. Therefore, the supporting rationale of the rejection of claims 1-6 applies equally as well to claim 47-52.

28. **Claims 55-60** list all the same elements of claims 11-16, but in program product form rather than method form. Therefore, the supporting rationale of the rejection of claims 11-16 applies equally as well to claims 55-60.

Claim Rejections - 35 USC § 103

29. **Claims 7, 9, 10, 24-32, 39, 40, 53 and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Radziewicz-Reilly as applied to claim 1 above, and further in view of Rainis et al. (Rainis), U.S. Patent No. 6,310,873.

30. Regarding **claim 7**, Radziewicz-Reilly discloses the invention substantially as claimed. However, Radziewicz-Reilly does not explicitly disclose including periodically performing fraud control, wherein the viewer program sends a pulse message to the access control system at predetermined intervals, and the access control system causes the communication link to the network to be severed if it fails to receive an expected pulse message.

31. In the same field of endeavor, Rainis discloses (e.g., telephonic communications over the internet). Rainis discloses including periodically performing fraud control, wherein the viewer program sends a pulse message to the access control system at predetermined intervals, and the access control system causes the communication link to the network to be severed if it fails to receive an expected pulse message [see Rainis, Col. 7, lines 15-25].

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32. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Rainis' teachings of telephonic communications over the internet with the teachings of Radziewicz-Reilly, for the purpose of providing a secure payment model between client software and a server in order to be able to monitor interaction between a client and a server [see Rainis, Col. 3, lines 35-54]. By this rationale **claim 7** is rejected.

33. Regarding **claim 9**, Radziewicz-Reilly and Rainis further discloses wherein the fraud control comprises comparing ad information in the local database with actual ad file information for the corresponding ad file, and indicating fraud if there is a discrepancy [see rejection of claim 7, supra]. By this rationale **claim 9** is rejected.

34. Regarding **claim 10**, Radziewicz-Reilly and Rainis further discloses wherein the viewer program terminates the network connection if fraud is indicated [see Rainis, Col. 7, lines 20-24]. The motivation that was used in the combination of claim 7, applies equally as well to claim 10. By this rationale **claim 10** is rejected.

35. Regarding **claim 24**, Radziewicz-Reilly and Rainis further discloses an access control system that provides a user computer with access to files of a network to which the user computer is connected, the access control server comprising: a central processing unit that can establish communication with the user computer [see Radziewicz, Col. 6, lines 33-64]; program memory that stores programming instructions that are executed such that the access control system receives requests from the user computer for ad files [see Radziewicz, Col. 6, lines 33-64], wherein the user requests are generated by a viewer program of the user computer after detecting times when the user is not actively sending or receiving data from the network [see

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Radziewicz, Col. 6, lines 13-16], such that the viewer program maintains a pool of ad files at the user computer for display [see Radziewicz, Col. 10, line 39] and performs ad pool management tasks [see Reilly, Col. 6, lines 17-61], and wherein the viewer program sends a pulse message to the access control system at predetermined intervals [see Rainis, Col. 7, lines 15-25], and the access control system causes the communication link to the network to be severed if it fails to receive an expected pulse message [see Rainis, Col. 7, lines 15-25], further wherein the viewer program maintains an ad information table that includes ad file information initially received from the access control system [see rejection of claim 17, *supra*], such that the viewer program compares actual ad file information determined by the user computer with corresponding ad file information in the table [see rejection of claim 7, *supra*], and such that the access server causes the communication link to the network to be severed if there is a discrepancy [see rejection of claims 7 and 8 *supra*]. The same motivation that was utilized in claim 7 applies equally as well to claim 24. By this rationale **claim 24** is rejected.

36. Regarding **claim 25**, Radziewicz-Reilly and Rainis further discloses wherein the access control server compares ad information in the local database with actual ad file information for the corresponding ad file, and indicates fraud if there is a discrepancy [see rejection of claim 7, *supra*]. By this rationale **claim 25** is rejected.

37. Regarding **claim 26**, Radziewicz-Reilly and Rainis further discloses wherein the programming instructions cause the access control sever to establish a communication link with the user computer by performing the operations of: receiving user identification information [see Radziewicz, Col. 6, lines 39-41]; verifying demographic information for the identified user stored at the access control system and providing the communication link [see Reilly, Col. 7,

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lines 50-67 and Col. 8, lines 1-35]; collecting demographic information from the user computer in an initial registration and access operation [see Reilly, Figures 2 and 5], storing the demographic information at the access control system and identifying it with the registered user, and providing the communication link [see Reilly, Figures 2 and 5]; and otherwise terminating the communication link and denying network access. By this rationale **claim 26** is rejected.

38. Regarding **claim 27**, Radziewicz-Reilly and Rainis further discloses wherein the operations performed by the access control server further include: determining ad impression viewing data corresponding to the number of times each ad file in the ad pool has been viewed [see Reilly, Col. 5, lines 60-67 and Col. 6, lines 1-10]; determining click through data corresponding to network addresses visited by the user during the viewing of an ad file [see Reilly, Col. 5, lines 60-67 and Col. 6, lines 1-10]; and reporting the ad impression viewing data to the access control system [see Reilly, Figures 2 and 5]. By this rationale **claim 27** is rejected.

39. Regarding **claim 28**, Radziewicz-Reilly and Rainis further discloses wherein the operations performed by the access control server further include preparing a Demographic Report that summarizes the reported ad impression viewing data for multiple computer users over a current time period [see Reilly, Figure 2]. By this rationale **claim 28** is rejected.

40. Regarding **claim 29**, Radziewicz-Reilly and Rainis further discloses wherein the operations performed by the access control server further include providing the Demographic Report to a computer user identified as an ad file sponsor [see Reilly, Figure 2]. By this rationale **claim 29** is rejected.

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41. Regarding **claim 30**, Radziewicz-Reilly and Rainis further discloses wherein the Demographic Report includes demographic report fields that are selected by the computer user [see Reilly, Figure 5]. By this rationale **claim 30** is rejected.

42. Regarding **claim 31**, Radziewicz-Reilly and Rainis further discloses wherein the access control server further provides archival reports for prior time periods [see Reilly, Figure 2]. By this rationale **claim 31** is rejected.

43. Regarding **claim 32**, Radziewicz-Reilly and Rainis further discloses wherein the operations performed by the access control server further include: comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file [see rejection of claim 27, *supra*]; identifying a time period over which the ad file should be played [see Radziewicz, Col. 7, lines 18-55]; adding the ad file to a playlist for each registered computer user if the ad file is matched to the computer user demographic information and if the identified time period is available for the computer user [see Reilly, Col. 7, lines 48-67 and Col. 1-67]; and decreasing an available ad file impression number for each identified and matched computer user (The Examiner takes Official Notice, see MPEP 2144.03). By this rationale **claim 32** is rejected.

44. Regarding **claims 39 and 40** have similar limitations as that of claims 7 and 10, therefore, they are rejected for the same rationale as discussed above.

45. **Claims 53-54** list all the same elements of claims 7 and 10, but in program product form rather than method form. Therefore, the supporting rationale of the rejection of claims 7 and 10 applies equally as well to claims 53-54.

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Allowable Subject Matter

46. Claims 8 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

47. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

48. In response to applicant's argument that references are not properly combinable or modifiable if their intended function is destroyed, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

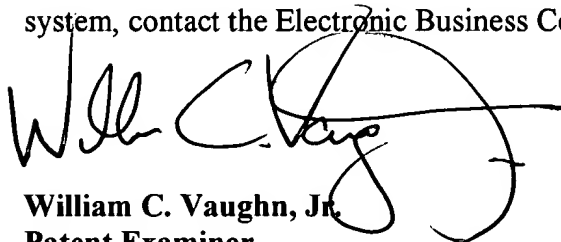
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Conclusion

49. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'William C. Vaughn, Jr.', with a large, stylized flourish extending from the end of the signature.

William C. Vaughn, Jr.
Patent Examiner

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11 June 2004